

REMARKS

Case Summary

Prior to addressing the substance of the Office Action mailed on March 27, 2002, the Applicants believe a brief summary of the current invention will advance the prosecution of the pending application. Additionally, the Applicants appreciated the Examiner's comments during the phone conversation on May 9, 2002.

The current invention relates to a novel form of electrolytic manganese dioxide (EMD). EMD is widely used as the cathode material of alkaline batteries. The EMD of the current invention has improved electro-chemical characteristics when compared to prior art EMD. As indicated at page 9, lines 6-7, the EMD of the current invention has a very high discharge capacity when tested at high discharge rates ranging from 1 to 3 watts in AA-cells. Table I, found on page 11, further details the improved electro-chemical characteristics of the improved EMD provided by the current invention. Specifically, when compared to prior art EMD, the EMD of the current invention demonstrated significant improvement in the following characteristics: discharge energy, intrinsic discharge capacity, initial open circuit voltage and compressed density.

One skilled in the art of preparing cathodes using EMD will recognize that the measured characteristics of the EMD of the current invention reflect solely the EMD. The values reported in Tables I, II and III on pages 11, 23-24 and 37 respectively do not include or reflect the influence of any other components used in the construction of the cathode. Thus, the values represent the improvements provided by the EMD of the current invention.

Rejection of the Claims

The Examiner rejected claims 17-25 for indefiniteness under 35 U.S.C. § 112, second paragraph. The Applicants respectfully traverse this rejection and request reconsideration thereof.

The pending claims were initially rejected in an Office Action dated August 28, 2001. In the initial rejection the Examiner indicated that the claims were indefinite for being defined in terms of a single property. To support the rejection, the Examiner cited Ex parte Spacht, 165 U.S.P.Q. 409 (CPAI 1969).

On October 24, 2001, the Applicants responded to the Office Action noting that claim 17 clearly indicated two properties of the EMD. Further, the Applicants noted that Ex parte Spacht did not support the Examiner's contention.

In the Office Action dated March 27, 2002, the Examiner issued a final rejection of the pending claims. The Examiner categorized the final rejection as a §112, second paragraph rejection. Specifically, the Examiner stated:

It is precisely the definition of a material in terms of a single property, which does not limit the claim technology. In other words, the disclosure is not commensurate in scope of the claim, which would include tremendously speculatively broad groups of material which when combined with EMD would provide the single property. (Emphasis added.)

It is well settled that a rejection asserting that the disclosure is not commensurate with the claimed subject matter is not a rejection based on §112, second paragraph. Rather, rejections of this nature must be based on §112, first paragraph. See, In re Borkowski and Van Venrooy, 164 U.S.P.Q. 642, 645-646 (C.C.P.A. 1970); In re Wakefield and Foster, 164 U.S.P.Q. 636, 641 (C.C.P.A. 1970). Thus, the current rejection of the claims no longer falls under 35 U.S.C. §112, second paragraph and constitutes a new grounds for rejecting the claims.

The new grounds for rejecting the claims raised by the Examiner did not arise out of an amendment of the claims or specification; therefore, the Applicants submit that the finality of the rejection is improper. Please see MPEP 706.7(a) which states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the

period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).
(Emphasis added.)

Turning now to the substance of the rejection, it is well settled that “[a]ny assertion by the Patent Office that the enabling disclosure is not commensurate in scope with the protection sought must be supported by evidence or reasoning substantiating the doubts so expressed.” In re Dinh-Nguyen and Stenhagen, 181 U.S.P.Q. 46, 47 (C.C.P.A. 1974). See also, In re Marzocchi and Horton, 169 U.S.P.Q. 367 (C.C.P.A. 1971). When rejecting an application under 35 U.S.C. §112, first paragraph, the Examiner has the burden of substantiating the rejection with acceptable evidence or reasoning. In re Budnick, 190 U.S.P.Q. 422, 423 (C.C.P.A. 1976). Therefore, in view of the Examiner’s failure to properly support the §112, first paragraph rejection with sufficient details as to the failings of the specification, the Applicants respectfully request that the rejection be withdrawn.

In order to advance the prosecution of the application, the Applicants have also submitted the foregoing amendments to the claims. The amendments are merely intended to help clarify the subject matter of the current invention. The amendments are fully supported by the specification and do not constitute new matter.

Finally, as a supplement to the Applicants’ response dated October 24, 2001, the Applicants respectfully direct the Examiner’s attention to Ex parte Schaefer, 171 U.S.P.Q. 110 (Pat. Off. Bd. App. 1970). In Ex parte Schaefer, the Board plainly stated that “[o]mission of some of the elements of the device makes the claim broad, but not vague, indefinite or misdescriptive.” In the currently pending application the claims clearly state a measurable limiting element of the current invention. Therefore, in view of Ex parte Schaefer, the claims are not indefinite.

In view of the foregoing arguments over the §112, first paragraph, rejection and the amendments to the claims, the Applicants respectfully request that the Examiner reconsider and withdraw the rejection of the pending claims. A formal Notice of Allowance of claims 17-25 is

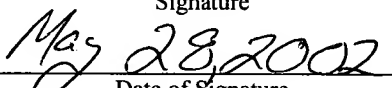
earnestly solicited. Should the Examiner care to discuss any aspect of the foregoing response in greater detail, the undersigned attorney would welcome a telephone call.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, Washington, D. C. 20231, on May 28, 2002.

WILLIAM D. HALL

name of applicant, assignee
or Registered Representative


Signature


Date of Signature

Respectfully submitted,



William D. Hall
Registration No. 35,535
McAFEE & TAFT
Tenth Floor, Two Leadership Square
211 North Robinson
Oklahoma City, Oklahoma 73102
Telephone: (405)-552-2218
FAX No. (405) 228-7418
E-Mail: bill.hall@mcafeetaft.com

Attorney for Applicants
May 28, 2002

C



RECEIVED
JUN 10 2002
TC 1700

Attorney Docket Number – 1060A
Serial No. 09/610,821

VERSION OF AMENDED CLAIMS WITH MARKINGS TO SHOW CHANGES MADE

17. An improved cathode material comprising EMD, said EMD having an AA-cell discharge capacity at a 1 watt discharge rate of about 68.2 milliamper hours per gram or higher and an AA-cell discharge energy at a 1 watt discharge rate of about 755 milliwatt hours or higher.
18. An improved cathode material comprising EMD, said EMD having an intrinsic discharge capacity of about 254.6 milliamper hours per gram or higher.
19. An improved cathode material comprising EMD, said EMD having an initial open circuit voltage of about 1.639 volts or higher.
20. An improved cathode material comprising EMD, said EMD having a compressed density of about 3.162 grams per cubic centimeter or higher.
21. An improved cathode material comprising EMD, said EMD having a % MnO₂ of about 91.9 or higher.
22. An improved cathode material comprising EMD, said EMD having a % Mn of about 60.1 or lower.
23. An improved cathode material comprising EMD, said EMD having a % structural H₂O of about 3.28 or lower.
24. An improved cathode material comprising EMD, said EMD having a BET surface area of about 23.5 sq. meters per gram or lower.
25. An improved cathode material comprising EMD, said EMD having a total pore volume of 27 cubic centimeters per kilogram or lower.